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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,602	03/05/2002	David Arthur Berkley	2685/5944	7682
23838	7590	09/21/2006	EXAMINER	
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			PARK, JUNG H	
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			2616	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,602

Applicant(s)

BERKLEY ET AL.

Examiner

Jung Park

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 102-202 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 132-143 and 183-194 is/are allowed.
- 6) ☒ Claim(s) 102-119, 121, 122, 124-131, 144-172, 174, 175, 177-182 and 195-202 is/are rejected.
- 7) ☒ Claim(s) 120, 123, 173 and 176 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on March 22, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,546,005 (08/823,944) has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 180 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. Claim 180 recites the limitation "the step of playing the message. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 102, 103, 110-119, 127, 129, 130, 144-147, 149, 156-163, 166-172, 181, 195, 197-200 are rejected under 35 U.S.C. 102(e) as being anticipated by Segur (US 6,212,550, "Segur").

Regarding claim 102, Segur discloses, an active user registry system responsive to a request for communications contact information corresponding to a user, comprising:

- a computer (*10 fig. 1; fig. 2*); and
- a database (*fig. 4; 70 fig. 2*), linked to the computer (*as shown in fig. 2*), containing communications information for contacting the user (*as shown in fig. 4*) including a user identifier (*114 fig. 4*), a plurality of communications addresses (*116 & 120 fig. 4*) and information corresponding to the user's preferred communications options (*122 fig. 4*); wherein the system determines a communications address for contacting the user (*col. 3, ln. 3-23*) in accordance with a comparison (*178 fig. 6; col. 3, ln. 55-65 where converts ... used by the subscriber unit ...*) between a communications option accompanying the request (*"IN" fig. 1*) and the user's preferred communications options (*"OUT" fig. 1*).

Regarding claims 103 and 149, Segur further discloses, wherein the user identifier includes information representing at least one of the user's identity, the user's title, the user's occupation or personal information corresponding to the user (*114 fig. 4*).

Regarding claims 110 and 156, Segur further discloses wherein the information corresponding to the user's preferred communications options includes information received over a communications link from a personal information source associated with the user (*fig. 4; 60, 62 & 64 fig. 2*).

Regarding claims 111 and 157, Segur further discloses, wherein the communications address for contacting the user determined by the system corresponds to a communications option having at least one communications property (fig.4 where email address for routing).

Regarding claims 112 and 167, Segur further discloses, wherein the system further initiates a communications contact to the user (154 fig.5).

Regarding claims 113 and 168, Segur further discloses, wherein the communications contact to the user is initiated without providing the communications address to a subscriber making the request (fax to fax fig.1).

Regarding claims 114 and 169, Segur further discloses, wherein the system further receives a message to be delivered to the determined communications address (152 fig.5; fig.6).

Regarding claims 115 and 170, Segur further discloses, wherein the message to be delivered comprises at least one of a voice message or a text message (fig.1).

Regarding claims 116 and 158, Segur further discloses, wherein the system further converts a communication for the user into a form receivable by the user over at least one of the user's preferred communications options (fig.1; 178 fig.6; col.3, ln.55-65).

Regarding claims 117 and 159, Segur further discloses, wherein the system further delivers the converted communication to the user (180 fig.6).

Regarding claims 118 and 171, Segur further discloses, further comprising a voice interface for enabling interaction with, and control and management of, the system from any available voice-compatible communication interface (66 fig.2).

Regarding claim 119, Segur further discloses, further comprising a cache coupled to the database for storing information, for a particular subscriber, corresponding to an entry point to communications information for contacting the user stored in the database (col.3, ln.11-23).

Regarding claims 127 and 181, Segur further discloses, wherein the database further includes multimedia information corresponding to the user (fig.1).

Regarding claims 129 and 146, Segur further discloses, wherein the system is linked to at least one of a packet network and a telephone network (fig.2).

Regarding claims 130 and 147 Segur further discloses, wherein the packet network comprises at least one of the Internet or an intranet (62 fig.2).

Regarding claim 144, it is a claim corresponding to claims 102 and 110 and is therefore rejected for the similar reasons set forth in the rejection of claims 102 and 110.

Regarding claims 160 and 197, Segur further discloses the method of converting text portions of a facsimile message into a voice message (fig.3; col.2, ln.60-63).

Regarding claims 161 and 198, Segur further discloses the method of converting an e-mail message into a voice message (fig.3; col.2, ln.60-63).

Regarding claims 162 and 199, Segur further discloses the method of converting a voice message into a facsimile message (fig.3; col.2, ln.64-67).

Regarding claims 163 and 200, Segur discloses the converting method in what Srinivasan discloses the method of converting an e-mail message into a facsimile message (16 to 34 fig.1).

Regarding claim 145, it is a claim corresponding to claim 102 except the following claim limitations: receiving a request for communications contact information corresponding to a user (172 fig.6; col.3, ln.35-43) and searching a database (174 & 176 fig.6). Therefore, this claim is rejected for the same reasons set forth in the rejection of claim 102.

Regarding claim 166, Segur further discloses, comprising the step of after determining a communications address for contacting the user, providing over the communications network the determined communications address (from fig.5 to fig.6; col.3, ln.24-43).

Regarding claim 172, Segur further discloses, the step of retrieving from a cache maintained for a subscriber information corresponding to an entry point to communications information for contacting the user stored in the database (172 fig.6).

Regarding claim 195, it is a claim corresponding to claims 145 and 149 and is therefore rejected for the similar reasons set forth in the rejection of claims 145 and 149.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 104, 106, 150, and 152 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur.

Regarding claims 104 and 150, Segur discloses the plurality of communications addresses including a telephone number, e-mail address, and fax. (fig.1). Segur fails to disclose a current address for making direct communications contact with the user. However, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the current address to the database in order to have more options.

Regarding claims 106 and 152, Segur teaches an address for contacting the user by voice message (122 fig.4).

8. Claims 121, 122, 124-126, 128, 131, 148, 151, 153, 154, 174, 175, 177-180, and 182 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur in view of Elliott et al. (US 6,754,181, "Elliott").

Regarding claims 105, 107, 108, 151, 153, and 154, Segur lacks what Elliott discloses, an address for contacting the user by videophone (col.17, ln.37-42), an address for real-time IP messaging (col.17, ln.37-42), and a URL-compatible address for linking a Web page (col.173, ln.31-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include those addresses taught by Elliott into the database of Segur in order to provide hybrid communications tools to users.

Regarding claims 121 and 174, Segur lacks what Elliott discloses, the communication information for contacting the user is automatically updated in accordance with a change in a communications address for contacting the user (col.100, ln.11-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the automatic update method taught by Elliott into the method of Segur in order to provide the better service to users.

Regarding claims 122 and 175, Segur lacks what Elliott discloses, wherein the user may, subject to verification of the user's identity, update the communications information for contacting the user (col.100, ln.11-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to update user's identity in order to validate based on the newest information.

Regarding claims 124 and 177, Segur lacks what Elliott discloses, the database further includes a message including an message providing information about contacting the user (col.63, ln.39-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the message taught by Elliott into the database of Segur in order to provide more information about contacting user.

Regarding claims 125 and 178, Segur lacks what Elliott discloses, the message providing information about contacting the user includes an audio message (col.63, ln.39-50). This claim is rejected for the same reasons and motivation set forth in the rejection of claim 125.

Regarding claims 126 and 179, Segur lacks what Elliott discloses, wherein the database further includes a list identifying those persons entitled to access the message providing information about contacting the user (col.68, ln.31-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the access list taught by Elliott into the database of Segur in order to selectively allow access.

Regarding claims 128 and 182, Segur lacks what Elliott discloses, multimedia information corresponding to the user includes a Web page (col.173, ln.31-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include an address of a Web page in order to access personal home page via URL address.

Regarding claims 131 and 148, Segur discloses, the system is further linked to a Web site for accessing the system using a Web browser (col.173, ln.31-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to access the system using a web browser since web browsers communicate with web servers primarily using HTTP (hypertext transfer protocol) and the HTTP protocol follows TCP/IP protocol which is widely used at the time of invention.

Regarding claim 180, Segur lacks what Elliott discloses, the step of playing the message providing information about contacting the user in response to the request for user contact information (col.68, ln.31-45). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the step of playing taught by Elliott into the database of Segur in order to get contacting information.

9. Claims 109, 155, 164, 165, 196, 201, and 202 are rejected under 35 U.S.C. 103(a) as being unpatentable over Segur in view of Srinivasan (US 6,072,862, "Srinivasan").

Regarding claims 109 and 155, Segur lacks what Srinivasan discloses, wherein the information corresponding to the user's preferred communications options includes a communications option and at least one of the time of day, the day of the week, or information representing the identity of a person attempting to contact the user (col.2, ln.49-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the time and date information in order to provide better service to users.

Regarding claims 164 and 201, Segur lacks what Srinivasan discloses the method of converting text portions of a fax message into an e-mail message (from 14 to 34 fig.1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the conversion taught by Srinivasan into the converter of Segur in order to convert a fax message into an e-mail message.

Regarding claims 165 and 202, Segur lacks what Srinivasan discloses the method of converting a voice message into an e-mail message (from 18 to 34 fig.1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the conversion taught by Srinivasan into the converter of Segur in order to convert a voice message into an e-mail message.

Regarding claim 196, Segur discloses the step (a) of receiving a request for communications contact information corresponding to a user (152 fig.5; col.3, ln.24-34) and the step (b) of comparing a communications option accompanying the request with the user's preferred communications options (154 fig.5; col.3, ln.24-34).

Segur does not explicitly disclose the step (c) of determining whether there is a communications address for the user corresponding to a communications option having at least one communications property in common with the communications option accompanying the request and with the user's preferred communications options. However, Segur discloses the converting method from e-mail to text portions of fax (Segur, from 16 to 34 fig.1). Also Srinivasan discloses the converting method from text portions of fax to e-mail (Srinivasan, from 14 to 34 fig.1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the

determining step in order to figure out whether there is an address in the data stream itself. For example, e-mail address has its own address data stream itself.

Segur lacks what Srinivasan discloses the step (d), if there is a communications address for the user corresponding to a communications option having at least one communications property (*from 14 to 34 fig.1 whether e-mail address has its own address*) in common with the communications option accompanying the request and with the user's preferred communications options, selecting the communications address (*col.3, ln.55 - col.4, ln.8*). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the address checking step in order to select the address and to convert fax message to e-mail message with its own address for delivering to the destination.

Segur discloses the step (e), if there is no communications address for the user corresponding to a communications option having at least one communications property (*col.3, ln.55 - col.4, ln.8 where check if the data stream has its own address*) in common with the communications option accompanying the request and with the user's preferred communications options, converting a communication for the user into a form receivable by the user over at least one of the user's preferred communications options (*from 16 to 34 fig.1*). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include the address checking step in order to convert e-mail address to the text portions of fax message, which does not have its own address in the data stream.

Allowable Subject Matter

10. **Claims 132-143 and 183-194** are allowed.

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11. Claims 120, 123, 173, and 176 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung Park whose telephone number is 571-272-8565. The examiner can normally be reached on Mon-Fri during 6:15-3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 571-272-3126. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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